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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/013,092	12/07/2001	Diane C. Moffi	36968-262340	2348
23552	7590	09/17/2004	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			AFSHAR, KAMRAN	
			ART UNIT	PAPER NUMBER
			2681	

DATE MAILED: 09/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/013,092

Applicant(s)

MOFFI ET AL.

Examiner

Kamran Afshar, 703-305-7373

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22-38 is/are allowed.
- 6) ☒ Claim(s) 1 and 17-21 is/are rejected.
- 7) ☒ Claim(s) 2-16 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 07 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4</u> . | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 17-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Joglekar (U.S. Patent 5,535,258).

With respect to claim 1, Joglekar discloses a method of making a hands-free mobile telephone call comprising the steps of: accessing an electronic telephone directory; searching the electronic telephone directory (See e.g. 200-1 through 200-N, Co. 8, Line 63 – Co. 9, Line 3); sending a signal to select an entry in the electronic telephone directory (See e.g. Co. 9, Lines 3-10); generating an audible announcement of the entry in the electronic telephone directory; and sending a signal to the mobile telephone to make the mobile telephone call (See e.g. Co. 9, Lines 10-18, For More Co. 9, Lines 19-37).

Regarding claim 17, Joglekar discloses accessing the electronic telephone directory comprises accessing an electronic telephone directory in the mobile telephone (See e.g. Co. 8, Line 63 - Co. 9, Line 37).

Regarding claim 19, Joglekar discloses generating an audible announcement of the entry in the electronic telephone directory includes using a speaker or earphone to permit a user to hear the audible announcement (See e.g. 438 of Fig. 8, 538 of Fig. 9 & Co. 11, Lines 42- 50).

Regarding claim 20, Joglekar discloses generating an audible announcement of the entry in the electronic telephone directory includes using a mobile telephone speakerphone or earphone to permit a user to hear the audible announcement (See e.g. Co. 9, Lines 3-17)

Regarding claim 21, Joglekar discloses generating an audible announcement of the entry in the electronic telephone directory includes using a motor-vehicle speaker or earphone to permit a user to hear the audible announcement (See e.g. 438 of Fig. 8, 538 of Fig. 9 & Co. 11, Lines 42- 50).

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Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joglekar (U.S. Patent 5,535,258) in view of Nishihara (U.S. Patent 5,561,712).

With respect to claim 18, Joglekar discloses everything as discussed above in claim 1. However, Joglekar does not teach the accessing the electronic telephone directory comprises accessing an electronic telephone directory in an external memory system. In the same field of endeavor, Nishihara discloses a hands-free phone set (See e.g. Title, Abstract) and external memory system (See e.g. 200 and 206 of Figs. 1-2). Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention to provide above teaching of Nishihara to Joglekar provide a controller and a memory accessing an electronic telephone directory in an external memory system.

Allowable Subject Matter

5. Claims 2-16, 22-38 are allowed.

The following is an examiner's statement of reasons for allowance: 2-16, 22-38.

With respect to claim 22, the prior art of record fails to disclose or render obvious that the mobile communications system comprising: a satellite remote having at least one means for scrolling through the electronic telephone directory; and means for sending a signal from the satellite remote to the mobile telephone.

With respect to claim 38, the prior art of record fails to disclose or render obvious that the mobile communications system comprising: a satellite remote having a scroll wheel for scrolling through the

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electronic telephone directory; an electronic voice generator for audibly announcing a party to be called; and a button for sending a signal from the satellite remote to the mobile telephone.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

6. Claims 2-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


With respect to claim 2, the prior art of record fails to disclose or render obvious that the satellite remote is used to access the electronic telephone directory, to search the electronic telephone directory, to select an entry in the electronic telephone directory, and to send the signal to the mobile telephone.

Conclusion

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Kamran Afshar whose telephone number is (703) 305-7373. The examiner can be reached on Monday-Friday.

If attempts to reach the examiner by the telephone are unsuccessful, the examiner's supervisor, David Hudspeth can be reached @ (703) 308-4825. The fax number for the organization where this application or proceeding is assigned is (703) 872-9306 for all communications.


Kamran Afshar


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